



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/823,449

04/13/2004

John R. Beck

020804

4708

26285

7590

03/18/2008

KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP
535 SMITHFIELD STREET
PITTSBURGH, PA 15222

EXAMINER

NGUYEN, CHI Q

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,449	Applicant(s) BECK ET AL.	
	Examiner CHI Q. NGUYEN	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-163 is/are pending in the application.
- 4a) Of the above claim(s) 1-17, 24-34, 42-109, 112-125 and 128-163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-23, 35-41, 110, 111, 126 and 127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/15/2004, 12/9/2004, 8/19/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of Group III (claims 18-23, 35-41, 110-111, and 126-127) in the reply filed on 11/15/2007 is acknowledged.

Status of Claims

Claims 1-17, 24-34, 42-109, 112-125, and 128-163 are drawn to non-elected claims and have been withdrawn.

Claim 164 has been cancelled.

Claims 18-23, 35-41, 110-111 and 126-127 are pending and have been examined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-23, 35-41, 110, 111, 126, and 127 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-28 of copending Application No. 11/019143. Although the conflicting claims

are not identical, they are not patentably distinct from each other because all of the features of the instant claims are included within the copending claims except for the copending claims further cites the steps of affixing specifically a first, a second joist rim and a first bearing wall, and a second wall instead of affixing a bearing wall having a plurality of vertically extending studs and affixing a plurality of floor joists as disclosed by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-23, 35-41, and 110-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,048,257 to Luedtke.

Claims 18, 35-37, 40, 110, 111:

Luedtke discloses a construction system comprising a lower support structure 50; a bearing wall 10 having a plurality of vertically extending studs 16 to the lower support structure; the vertical studs obviously extended between upper and lower support structures or tracks having a U-shaped in cross section, a joist rim 58 on the lower support structure adjacent to at least some of the vertically extending studs 16; the joist rim 58 to at least some of the adjacent vertically extending studs 16; a plurality of floor

joists 48 to the joist rim; and a floor deck 14 on the plurality of floor joists (see Fig. 1). Luedtke discloses the claimed invention as stated but does not disclose expressly the method steps such as constructing a lower support structure; affixing a bearing wall having a plurality of vertically extending studs to the lower support structure; supporting a joist rim on the lower support structure adjacent to at least some of the vertically extending studs; affixing the joist rim to at least some of the adjacent vertically extending studs; affixing a plurality of floor joists to the joist rim; and supporting a floor deck on the plurality of floor joists. Examiner considers this to be the obvious method of setting up applicant's device because in constructing a bearing wall, one must obviously position a plurality studs along a lower support structure, joint flooring joists to joist rim and placing floor deck on top of the flooring joists. Luedtke would be motivated to follow these steps to facilitate assembly a bearing wall and floor.

Claims 19, 38:

Wherein said supporting a floor deck on the plurality of floor joists comprises: supporting noncombustible board 14 on the plurality of floor joists; and affixing the noncombustible board to at least some of the floor joists 48.

Claims 20, 38, and 41:

Wherein said affixing the noncombustible board to at least some of the floor joists comprises attaching the noncombustible board with mechanical fasteners (see Fig. 3) to at least some of the floor joists.

Claim 21:

Wherein said affixing a plurality of floor joists to the joist rim comprises affixing a plurality of floor joists to the joist rim such that at least one of the floor joists is not aligned with any of the vertically extending studs (see Fig. 1).

Claim 22:

Wherein said affixing a plurality of floor joists to the joist rim comprises affixing a plurality of floor joists to the joist rim such that at least one of the floor joists is aligned with one of the vertically extending studs (see Fig. 1).

Claim 23:

Wherein said supporting a floor deck on the plurality of floor joists comprises supporting a pour-in-place cementitious material on said plurality of floor joists (see col. 5, line 48).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 3635

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

/C. Q. N./
Examiner, Art Unit 3635

/Richard E. Chilcot/
Supervisory Patent Examiner, Art Unit 3635